

Amendments to the Drawings:

The attached two (2) sheets of drawings include changes to Figs. 1-6. These two (2) sheets, which include Figs. 1-6, replace the original sheets including Figs. 1-6. In Figs. 1-6, descriptive labels for the illustrated components have been provided.

Attachments: Two (2) Replacement Sheets

REMARKS

I. INTRODUCTION

Claims 12-29 are pending in the present application. It is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested in view of the following explanation.

In response to the Examiner's objection to the drawings, Applicants have amended Figs. 1-6 to provide descriptive labels for the illustrated components. The amended figures are included in the attached two replacement drawing sheets.

II. REJECTION OF CLAIMS 12-25 & 27-29 UNDER 35 U.S.C. § 103

Claims 12-25 and 27-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,487,421 to Hess et al. ("Hess") in view of U.S. Patent 6,081,261 to Wolff et al. ("Wolff") and further in view of U.S. Patent 4,751,741 to Mochinaga et al. ("Mochinaga"). Applicant respectfully submits that this rejection should be withdrawn for at least the following reasons.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Not only must the cited references teach or suggest each element of the claim, but the prior art must also *suggest the desirability* of combining the elements in the manner contemplated by the claim. M.P.E.P. § 2143.01 (citing In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990)). The mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990).

Independent claim 12 recites “an **integrated telecommunication terminal in a single integrated housing**” including “a character recognition unit” and “a pressure receiving element,” with “the movement of the pressure receiving element detected by the at least one pressure sensor element being **converted into signaling information by the character recognition unit in the single integrated housing.**”

In support of the obviousness rejection, the Examiner cites Hess as teaching a telecommunication terminal having a plurality of data input units and a character recognition. The Examiner further cites Wolff as teaching a data input unit including a pressure sensor element and a pressure receiving element acting jointly with the pressure sensor element such that the movement of the pressure receiving element detected by the at least one pressure sensor element is convertible into signaling information by the character recognition unit. In addition, the Examiner cites Mochinaga as teaching “the character recognition unit and the pressure receiving unit, wherein the movement of the pressure receiving element detected by the at least one pressure sensor element is converted into signaling information by the character recognition unit in the single integrated housing.” (Office Action, p. 4).

While the Examiner recites the selective teachings of the applied prior art that the Examiner wishes to apply against Applicant’s claim 12, the Examiner only makes the following statements regarding the rationale for combining the selective teachings of the applied prior art: a) “it would have been obvious to . . . provide the teachings of Wolff into the device of Hess for recognizing when a written entry is made on a page”; and b) “it would have been obvious to . . . provide the teaching of Mochinaga into the device of Hess and Wolf so that the input signals can be corrected by the users.” Furthermore, although the Examiner concedes that the “combination of Hess, Wolff and Mochinaga discloses one confirmation device,” the Examiner concludes that “it would have been obvious to . . . replace a confirmation device 8 with a plurality of confirmation devices 8 . . . because input signals could be quickly corrected.” Applicant notes that the Examiner has not provided any objective evidence that the applied prior art actually suggests combining the elements in the manner contemplated by claim 12.

While it may be true that the combination asserted by the Examiner may be possible, the teachings of the three applied references do not provide any objective motivation for selectively combining the teachings in the manner suggested by the Examiner, particularly since the three applied references relate to disparate technical systems. In this regard, Hess teaches a mobile radio telephone that includes a motion detector for enabling input of graphic information (e.g., letters and digits), as well as a recognition device for character recognition; Wolff teaches a pen-like instrument for making written entries (as well as reading written data) and sensing the forces exerted on the writing tip, as well as the motion of the writing

tip, but the processing of the data from the pen-like instrument is performed in a separate base unit 92 (see, col. 9, l. 21-27); and Mochinaga teaches a pen-type character recognition device having a single correction device. In order to make the selective combination asserted by the Examiner, starting with the teachings of Hess, one of ordinary skill in the art has to initially overcome the fact neither Wolff nor Mochinaga relates to a telecommunication device. In addition, one of ordinary skill in the art has to selectively incorporate into the system of Hess the teachings of Wolff regarding a pressure sensor element and a pressure receiving element, although there is no motivation for such incorporation since the switch device and the motion sensor of Hess fully satisfy the needs of the Hess system, and such incorporation would completely change the principle of operation of Hess and/or render the system of Hess unsatisfactory for its original intended purpose, thereby rendering the obviousness conclusion incorrect as a matter of law. MPEP 2143.01 (citing In re Gordon, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984), and In re Ratti, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959)). Furthermore, one of ordinary skill in the art would have to selectively incorporate the correction device of Mochinaga into the combined system of Hess and Wolff.

Applicant respectfully submits that, without the teachings of Applicant, one of ordinary skill in the art simply would not be motivated to make the selective combination asserted by the Examiner, which means the Examiner's asserted combination is based on impermissible hindsight reconstruction. Even if one assumes for the sake of argument that the Examiner is not relying on the teachings of Applicant, the Examiner's asserted combination is essentially based on an "obvious-to-try" rationale, which is insufficient to support a *prima facie* obviousness: the mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). With respect to the subjective "obvious to try" standard, the cases of In re Fine, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988), and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), clearly indicate that the Examiner's generalized assertions that it would have been obvious to combine or modify the references relied upon do not properly support an obviousness rejection. In particular, the Court in the case of In re Fine stated: "Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . One cannot use hindsight reconstruction to **pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.**" In re Fine, 5 U.S.P.Q.2d at 1600 (citations omitted; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some

suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].

In re Jones, 21 U.S.P.Q.2d at 1943 & 1944 (citations omitted).

Applicant notes that the Examiner has offered no evidence whatsoever of actual suggestion in the applied prior art to make the asserted modification, but only conclusory hindsight, reconstruction and speculation, which the Court of Appeals for the Federal Circuit has indicated does not constitute evidence that will support a proper obviousness finding. Since the Examiner's asserted combination of Hess, Wolff and Mochinaga is based on improper hindsight reconstruction, rather than based on a suggestion from the prior art that is "clear and particular," the obviousness rejection of claim 12 is improper. See In re Dembiczak, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999).

For the reasons discussed above, claim 12 and its dependent claims 13-25 and 27-29 are not rendered obvious by the combination of Hess, Wolff, and Mochinaga. Accordingly, withdrawal of the obviousness rejection under 35 U.S.C. § 103(a) with respect to claims 12-25 and 27-29 is hereby respectfully requested.

III. REJECTION OF CLAIM 26 UNDER 35 U.S.C. § 103

Claim 26 stands rejected under 35 U.S.C. § 103(a) as being obvious over Hess in view of Wolff and Mochinaga, and further in view of U.S. Patent No. 6,104,388 to Nagai et al. ("Nagai").


Claim 26 ultimately depends from claim 12. Furthermore, Nagai clearly fails to remedy the deficiencies of Hess, Wolff and Mochinaga as applied against parent claim 12. Therefore, claim 26 is allowable for essentially the same reasons as those presented in connection with claim 12. Withdrawal of the obviousness rejection of claim 26 is respectfully requested.

IV. **CONCLUSION**

For the foregoing reasons, it is respectfully submitted that all of claims 12-29 are allowable. Since all issues raised by the Examiner have been addressed and obviated, an early and favorable action on the merits is therefore respectfully requested.

Respectfully submitted,

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